

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLF E. RUCK

Appeal No. 1998-0515
Application 08/425,196¹

ON BRIEF

Before CALVERT, ABRAMS and GONZALES, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 20. Claims 21 to 49, the other claims in the application, stand withdrawn from consideration under 37 C.F.R. § 1.142(b) as being directed to nonelected species.

¹ Application for patent filed April 17, 1995.

The claims on appeal are drawn to a mounting means for photographic prints, etc. They are reproduced in the appendix of appellant's brief (filed May 23, 1997).²

Claims 1 to 20 stand finally rejected for failure to comply with 35 U.S.C. § 112, second paragraph.³

As stated in In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970), the purpose of the second paragraph of § 112

is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

See also In re Zletz, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process").

In the present case, the examiner stated in the final rejection that claims 1 to 20 do not comply with § 112, second paragraph, because they

² On page 3 of the answer, the examiner notes a few errors in the copy of the claims. In addition to these, -- parallel to said length of said mounting strip and -- should be between "running" and "along" in claim 1, line 6.

³ Additional rejections of the claims under 35 U.S.C. § 112, first paragraph, § 102(b) and § 103(a) are withdrawn in the examiner's answer.

are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Examples of the indefinite errors are as follows: In claim 1, line 3, there is no antecedent basis for "the length". In claim 1, line 4, it is not understood how a single fold can form three members, i.e. a lip, a long leg and a short leg. In claim 1, section (d), line 1, it is not clear whether the applicant is positively claiming the external slot. (Pages 3 and 4).

On page 5 of the answer, the examiner gives further examples of language in claim 1 which he considers to be indefinite:⁴

in claim 1, line [12], "an external slot formed when said mounting strips are attached". It is unclear from the above whether the appellant is positively claiming the external slot. In claim 1, line [15], the phrase "whereby a plurality of said mounting strips may be fastened parallel to each other" is indefinite since it is not clear whether the appellant is positively claiming the plurality of mounting strips fastened parallel to each other. Examples of the same problem in claim 1 as mentioned above appear as follows: on line [27], the phrase "whereby, when said mounting strips are mounted"; line [40], "whereby, when said second parallel edge"; line [47], "whereby, when said second parallel edge".

Initially, we do not agree that the claims are narrative in form or not in one sentence.

Independent claims 1 and 11, for example, are each in one sentence, and, rather than being in narrative form, set out a combination of elements (a) to (d) (claim 1), or (a) to (e) (claim 11), followed by a number of "whereby" clauses.

⁴ In quoting from the examiner's statements, we have changed the line numbers where necessary to correspond to the lines of the claims as reproduced in the appendix of appellant's brief. The changed numbers are given in brackets.

Turning to the specific items in claim 1 identified by the examiner, we note initially that the test for indefiniteness under § 112, second paragraph, is "whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct." In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975) (emphasis added). Applying this test, we do not agree with the examiner that "the length" (line 3) lacks antecedent basis, since this term refers to "strips," which, being elongated members, necessarily have a length. As for the fold recited in line 3, it is clear from appellant's disclosure in Fig. 2 and page 10, lines 20 and 21 concerning fold 7, how a single fold can form a lip, a long leg and a short leg, as claimed. We also do not agree that the phrase "whereby a plurality may be fastened parallel to each other" (line 15) is indefinite, since it merely states a possible use of the claimed strips; likewise, the "whereby" clauses beginning on lines 40 and 47 simply state results of using the claimed apparatus, and add nothing to the patentability or substance of the claim. As such, they do not render the claim indefinite per se. See Texas Instruments Inc.v. Int'l. Trade Comm., 988 F.2d 1165, 1172, 26 USPQ2d 1018, 1023 (Fed. Cir. 1993), citing Israel v. Creswell, 166 F.2d 153, 156, 76 USPQ 594, 597 (CCPA 1948).

However, we do agree with the examiner that claim 1 is indefinite in its recitation of (1) "an external slot formed when said mounting strips are attached to any suitable flat surface" (lines 12 and 13), and (2) "whereby, when said mounting strips are mounted on said flat surface, the distance between said seams is substantially equal to the distance between two parallel edges of the print to be mounted" (lines 27 to 29). By using the term "when" in these expressions, rather than positively reciting that the strips are mounted on the flat surface at the specified distance, one of ordinary skill would not be reasonably apprised of the scope of claim 1. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In particular, one of ordinary skill could not reasonably determine whether claim 1 was of such scope as to cover mounting strips attached to a flat surface, so that there would be an external slot (claim 1, part (d)), and so that the distance between the seams would be as recited in claim 1, lines 27 to 29, or whether claim 1 was of some broader scope, e.g., as to cover the mounting strips unattached. For this reason, we conclude that claim 1 does not comply with 35 U.S.C. § 112, second paragraph, and will sustain the rejection of claim 1, and therefore of dependent claims 2 and 10.

Claim 11 likewise does not comply with § 112, second paragraph. While this claim, unlike claim 1, does claim a base with a flat surface as element (a), its scope is still indefinite because it would not be reasonably clear to one of ordinary skill what the scope of the claim was, for the reasons discussed above with respect to claim 1. The rejection of claims 11 to 20 will accordingly be

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sustained.

Rejections Pursuant to 37 C.F.R. § 1.196(b)

Pursuant to 37 C.F.R. § 1.196(b), we enter the following new rejections:

- (1) Claims 3 and 13 are rejected for failing to comply with 35 U.S.C. § 112, second paragraph, in that they recite that the thickness of the seam "may be sufficient to form a gap [etc.]." Such a recitation that claimed structure "may be" a certain size leaves it unclear as to whether the scope of the claim is so limited, or not. Cf. Ex parte Hasche, 86 USPQ 481, 482 (Bd. Apps. 1949) (expressions such as "which may be" do not properly define the invention with particularity).
- (2) Claims 6 and 16 are rejected under 35 U.S.C. § 112, second and fourth paragraphs. The fourth paragraph of § 112 provides, inter alia, that "a claim in dependent form shall . . . specify a further limitation of the subject matter claimed." The recitation in these claims that "said long leg of said mounting strips is longer than said short leg" is not a further limitation of parent claims 1 and 11, respectively, because a "long leg" is necessarily longer than a "short leg."⁵ Alternatively, if this is intended to be a further limitation, claims 6 and 16 are indefinite under § 112, second paragraph, because it is not evident what that further limitation is.

Conclusion

The examiner's decision to reject claims 1 to 20 is affirmed. Claims 3, 6, 13 and 16 are rejected pursuant to 37 C.F.R. § 1.196(b).

⁵ The "whereby" clause in claims 6 and 16 does not constitute a further limitation. Texas Instruments, supra.

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In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejections pursuant to 37 C.F.R. § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 C.F.R. § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 C.F.R. § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 C.F.R. § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 C.F.R. § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or

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145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED
37 C.F.R. § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	APPEALS AND
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